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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/072,721

02/06/2002

Kiyotaka Matsuno

15252

1963

7590 02/18/2009
Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

EXAMINER

MENDOZA, MICHAEL G

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

02/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/072,721 | Applicant(s) MATSUNO ET AL. | |
| | Examiner MICHAEL G. MENDOZA | Art Unit 3734 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 2/5/2009 have been fully considered but they are not persuasive.
2. As to the argument that Matsuno is reuseable; the examiner agrees, however any device can be disposed of. As to the argument that the clipping device is of Matsuno is not irreclaimable, the examiner disagrees. The initial coupling member that is used would not be able to be used again. As to the argument that that Matsuno does not prevent subsequent inadvertent clip attachment, the examiner disagrees. Due to the construction of Matsuno, a user would have to purposely attach a new coupler member to attach a new clip. Since a user would be purposely attaching a new coupler it would be there not be inadvertent. Also see the below rejection of forming two pieces into one piece. The coupler would be irreclaimable when formed in one piece as rejected below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 55-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuno 5766189.

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5. Matsuno discloses the claimed invention except for wherein the coupling member is irremovalby fixed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the coupling member is irremovably fixed, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involved only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

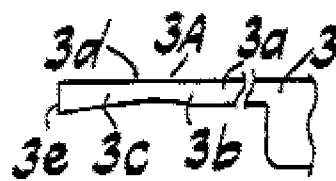
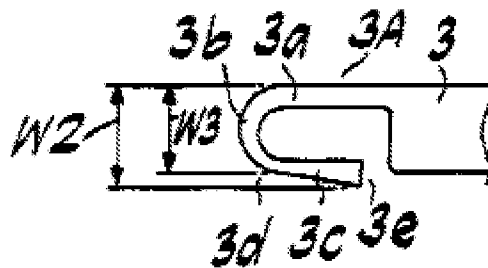
6. Matsuno fails to teach wherein the operation wire and coupling are connected to each other by press working, wherein the operation wire and coupling member are connected to each other by passing the actuation wire through a hole of the coupling member and by turning the operation wire back, or wherein the operation wire and coupling member are connected to each other by welding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to connect the wire and coupling member as recited in the claims because the particulars of the connection are a mere design choice. Furthermore, the Applicant has not disclosed why the particulars of the operation wire are of importance or solve a stated problem or provide an advantage over the prior art.

7. Furthermore, claims 55, 56, 61, 62, and 67 are product-by-process claims. A product-by-process claim is not limited to the manipulation of the recited step, only the structure implied by the step. The claimed product appears to be the same or similar to that of the prior art.

8. As to claims 55-72, Matsuno teaches a disposable clipping device for clipping tissue in the body of a patient comprising: a sheath member; an actuating wire; a

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coupling member; a clip unit having a tissue clip; wherein the clipping device is disposable; and the coupling member is fixed to the actuating wire, and when the clip clips tissue, the clipping member is rendered irreclaimable while being kept fixed with the actuating wire, released from the clip unit, and remains at the distal end of the actuating wire; an insertion tube that is fitted over the sheath member and movable longitudinally relative to the same; a first operation unit mounted in the area of the proximal end of the insertion tube, as well as a second operation unit for exercising a pulling action on the actuation wire, wherein the second operation unit is provided with a slider that is coupled to the proximal end of the actuating wire; wherein the coupling member is provided with a hook; and wherein the insertion tube is provided with raised portions at its inner surface and/or its outer surface.

FIG. 2A**FIG. 2B**

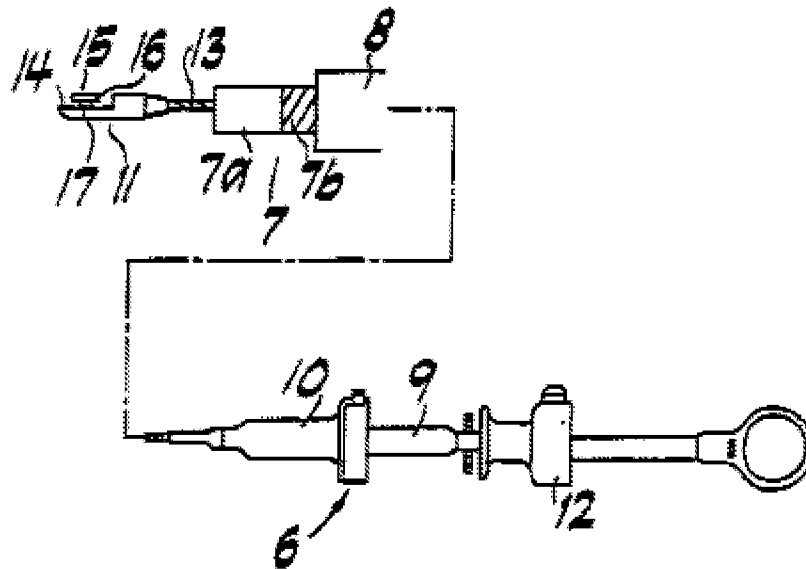


FIG. 3

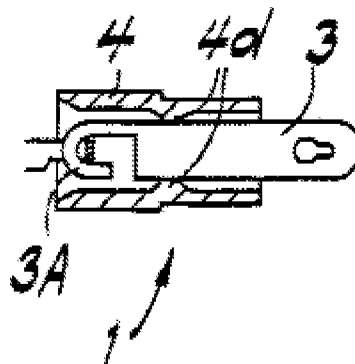


FIG. 9A

9. As to claims 60, 66, and 72, Matsuno teaches the clipping device of claims 55, 61, and 67. It should be noted that Matsuno fails to teach wherein the clipping device is arranged in a packing unit. However, it is well known in the art of disposable surgical devices to pack the devices to maintain sterility. Therefore it would have been obvious

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to one having ordinary skill in the art at the time the invention was made to pack the device to maintain the sterility of the device before use.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL G. MENDOZA whose telephone number is (571)272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. G. M./
Examiner, Art Unit 3734

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/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3734